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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,027	10/17/2001	Guenaelle Martin	214862US0	3816

22850 7590 11/17/2004

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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YU, GINA C

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/978,027

Applicant(s)

MARTIN ET AL.

Examiner

Gina C. Yu

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 September 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.  
2. ☒ The proposed amendment(s) will not be entered because:  
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ they raise the issue of new matter (see Note below);  
(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see continuation sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see continuation sheet.  
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.  
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

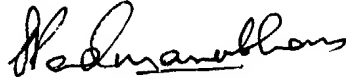
Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1-18.

Claim(s) withdrawn from consideration: none.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.  
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). filed 2/23/2004.  
10. ☐ Other: \_\_\_\_\_

  
SREENI C. ARJUNAN  
SUPERVISORY PATENT EXAMINER

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Continuation from No. 2

The proposed amendments are not entered because the amendments raise new issues that require further search and consideration. Claim 1 contains new weight limitation of 0.7-5 % by weight of compound (I). While the original claim, claim 4, also limit the weight of the same compound to 0.5-3 %, the proposed amendment contains broader limitation.

Continuation from No. 5

Applicants assert that claims 17 and 18, which are directed to compositions void of histamines, present no new matter as none of the disclosed examples in the original specification contain histamines. Examiner respectfully reiterates that negative proviso requires support from the original disclosure, and that mere absence of a positive recitation is not basis for exclusion. See In re Grasselli 231 U.S.P.Q. 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984).

Regarding the rejection made under 35 U.S.C. § 102(b) over Boussouira (EP 2779060), applicants assert that the reference fails to teach or suggest adding retinol with the claimed camphorsulphonic acid derivatives among other sunscreens with the expectation that the particular compound would stabilize retinol. The argument is unpersuasive because the reference teaches that the compound is particularly preferred. Furthermore, the present rejection is based on anticipation, rather than obviousness standard. The reference teaches that the claimed composition and the practice of combining retinol with camphorsulphonic compound are already known and anticipated.

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Applicants also assert that the Office has not provided evidence to show that the prior art composition stabilizes retinol as claimed by applicants. The argument is unpersuasive since the prior art composition comprising the same components as the claimed invention inherently has the same physical properties.

Regarding the rejection made under 35 U.S.C. § 103 (a) over Harding (US 5705144) in view of Forestier et al. (US 5302376), applicants assert that Harding fails to teach, suggests or recognizes that UVA sunscreens can degrade retinol. However, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In this case, the motivation to combine the references is found as the Harding reference specifically teaches to use retinol with a sunscreen to “enhance the photo-stability or its derivative”, and the Foresitier reference teaches the photostability of the specific camphorsulphonic sunscreen compound. The advantagewhich applicants have recognized, i.e., preventing the degradation of retinol, would have been obvious to the routineer or otherwise flow naturally from following the suggestion of the prior arts.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635. The examiner can normally be reached on Monday through Friday, from 8:30 AM until 6:00 PM..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu  
Patent Examiner